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In re Application of
Mario N. Lioubin et al
Serial No.: 10/056,790
Filed: January 23, 2002
Attorney Docket No.: EX02-004C

: PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed May 6, 2004, requesting withdrawal of Finality of the last Office action. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on August 1, 2003, setting a three month shortened statutory period for reply in which claims 8-12 were rejected under 35 U.S.C. 112, second paragraph, as indefinite, and under first paragraph, as lacking enablement.

Applicants replied on October 27, 2003, by removing hyperlinks from the specification and amending claim 8, all non-elected claims (1-7 and 13-51) being canceled. Applicants argued the amendments overcame each of the rejections of record.

The examiner mailed a Final Office action to applicants on January 9, 2004, setting a three month shortened statutory period for reply. The examiner maintained the rejection under 35 U.S.C. 112, second paragraph, for essentially the same reasons as before and replied to applicants' arguments. The examiner also set forth a rejection under 35 U.S.C. 112, first paragraph, for lack of written description. The examiner made the action Final.

Applicants, in a telephone interview with the examiner, and then by reply filed February 25, 2004, objected to the finality of the Office action and the examiner agreed that the finality was improper. The impropriety was based on a new ground of rejection having been made which was not necessitated by applicants' amendments. The reply addressed both rejections and further amended claim 8.

The examiner mailed a new Office action to applicants on March 22, 2004, noting that the previous Office action was improper and withdrawing it in favor of the current Office action. The examiner then repeated the rejections of the previous Office action. The examiner noted the amendment of February 25, 2004, but refused to enter the amendment as not complying with requirements of form from a previous Office action. The examiner then made the action Final, reasoning that applicants' amendments necessitated the new ground of rejection.

Applicants filed this petition on May 6, 2004, requesting that the finality be withdrawn as improper, as well as a reply to the Office action.

DISCUSSION

Applicants petition the Finality of the last Office action on the basis that the new rejection made in the Final Office action of March 22, 2004, was not necessitated by applicants actions or amendments. Applicants further question the non-entry of the amendments filed February 25, 2004.

The examiner's actions are contradictatory on their face. Having made a rejection Final (January 9, 2004) and then having agreed that the finality was premature and would be withdrawn, the examiner had no right to refuse entry of the amendment filed February 25, 2004, except for matters of non-compliance with 37 CFR 1.121. So far as can be determined the amendment complies with the Rules and should have been entered as a matter of right since the response was to a non-Final Office action (which had originally been made Final). The next Office action also specifically withdraws the previous Office action (see first paragraph, page 2), thus the amendment filed February 25, 2004, is merely a supplemental amendment to the amendment of October 27, 2004, and entitled to entry as a further reply to a non-Final Office action.

The examiner then repeats the rejections of the Office action of January 9, 2004, with little modification and no consideration of the supplemental reply and makes the action Final arguing that applicants' amendment (which one is not stated) necessitated the new ground of rejection. This is also contradictatory since the amendments to claim 8 merely further define and clarify by insertion of SEQ ID No's terms already in the claims. If these terms now lack written description, they must have lacked written description when first considered. No written description rejection was made in the first Office action and its appearance in the second and subsequent Office actions as a replacement for the enablement rejection in the first Office action constitutes a new ground of rejection which was not necessitated by applicants' amendments to the claims. Thus the Finality of the Office action of March 22, 2004, is in error and is withdrawn.

The petition is **GRANTED**. The Office action mailed March 22, 2004 is designated a non-Final Office action

As applicants have replied to the March 22, 2004 Office action, the response will be entered and the application will be forwarded to the examiner for further consideration.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 703-872-9306.

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